

Appeal Brief  
Serial No.: 10/009,990  
Attorney Docket No.: NIDN-73132

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Earl Harling, *et.al.*

Application No. : 10/009,990

Filing Date : June 30, 2003

Art Unit : 3771

Title : VENTILATION SYSTEMS

Docket No. : NIDN-73132

Mail Stop Appeal Brief–Patents

Commissioner for Patents

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**APPEAL BRIEF**

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## **I. REAL PARTY IN INTEREST**

The real party in interest in this Appeal is GE Healthcare, Inc., a part of General Electric (“GE”).

## **II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences related to the instant appeal.

## **III. STATUS OF CLAIMS**

Claims 9-11 are pending in this application. The Examiner has rejected all of these claims. Claims 9-11 as amended during prosecution are reproduced in the **Claims Appendix** attached hereto. Appellants are appealing the rejection of Claims 9-11.

## **IV. STATUS OF AMENDMENTS**

A final Office Action was mailed on March 16, 2009. No claims have been amended thereafter.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Independent Claim 9 describes a ventilation system comprising an induction chamber consisting of a plurality of compartments, including a first compartment where animals are initially anaesthetized having means for the supply and removal of anaesthetic, and a second compartment connected to an inlet, the compartments being arranged such that anaesthetic escaping from the first compartment passes into the second compartment and thence to the inlet.

Support for this claim can be found on page 6, line 18 to line 32 of the specification of international publication no. WO 00/74593.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The issues for review in this appeal arise from an Office Action dated March 16, 2009. The Examiner rejected claims 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Jaeger to U.S. Patent No. 5, 297,502 (“Jaeger”) in view of Levy to U.S. Patent No.: 4,332,244 (“Levy”).

Therefore, the issue in this appeal is:

1. Whether Jaeger in view of Levy disclose, teach, or suggest all the elements of claims 9-11?

## **VII. ARGUMENT**

The Examiner rejected Claims 9-11 under 35 U.S.C. § 103 (a) as being unpatentable over Jaeger to U.S. Patent No. 5, 297,502 (“Jaeger”) in view of Levy to U.S. Patent No.: 4,332,244 (“Levy”).

Appellants respectfully request that The Board of Patent Appeals and Interferences (“Board”) should reverse the Examiner’s rejection for the reasons set forth below.

**A. The Examiner’s Rejection of Claims 9-11 Should be Reversed Since Jaeger in view of Levy Fails to Disclose, Teach or Suggest All the Elements of Claims 9-11.**

The Examiner’s Rejections of Claims 9-11 should be reversed since Jaeger to U.S. Patent No. 5, 297,502 (“Jaeger”) in view of Levy to U.S. Patent No.: 4,332,244 (“Levy”) fails to disclose, teach, or suggest all the elements of claims 9-11.

Appellants are well aware of both Jaeger and Levy. Appellants disclosed Jaeger and Levy in their original U.S. application filing on June 8, 2000.

On page 4 of the final Office Action, the Examiner states “that with a minimal amount of experimentation one of ordinary skill would be able to modify the Jaeger device to accommodate a liquid anesthetic and the precise amount of gas/liquid anesthetic would be ascertained by the minimal experimentation.” In response, Jaeger’s system, unlike the present invention, does not account for the required modifications necessary for use in animals that require a volatile liquid anaesthetic to be vaporized.

Additionally, on page 9 of the present invention’s specification, Appellants also present the schematic differences between the prior art systems versus the present ventilation system. Figure 1 depicts a prior art system similar to Jaeger. Applicants respectfully request the Examiner note the differences between the figures as discussed herein above.

Jaeger specifically relates to an inhalation system for supplying gas directly to the

respiratory tract of a plurality of experimental animals. The present invention, however, specifically relates to anaesthetizing animals via a ventilation system for use in a surgery suite. Unlike Jaeger, the current ventilation system was modified in order to allow it to be used on small animals such as rats. As disclosed in the present invention, volatile liquid anaesthetic must be vaporized using a vaporizer prior to its use with humans or animals as an anaesthetic. However, prior art anaesthetic systems using vaporizers are designed for use with humans or large animals. Accordingly, a part of the novelty of the present invention's system was that it is modified to accommodate smaller animals. (See page 2 and tables 1-3 of the specification).

Jaeger does not teach, disclose, or suggest using its invention for anesthetic purposes and further more its system, unlike the present invention, does not account for the required modifications necessary for use in animals that require a volatile liquid anaesthetic to be vaporized. It is well settled in case law that prior patents are references only for what they clearly disclose or suggest. Additionally, it is not proper use of a patent as a reference to modify its structure to one which prior art references do not suggest. *In re Randol and Redford*, 425 F.2d 1268, 165 U.S.P.Q. 586, 588 (C.C.P.A. 1970). A reference must be considered not just for what it expressly teaches, but also for what it fairly suggests to one who is unaware of the claimed invention. *In re Baird*, 16 F.3d 380, (Fed. Cir. 1994).

Further, unlike the present invention, Levy uses only masks for delivering anesthetic gases to a laboratory animal. As well, unlike the present invention, Levy does not teach, suggest, or disclose using breathing station compartments that would fill a chamber compartment with anesthetic without the use of masks to deliver anesthetic gases to laboratory

animals. Therefore, unlike the present invention, Levy is unable to administer liquid anaesthetic to the laboratory animals. Nor is Levy able to deliver precise amounts of gas anesthetics like the present invention. Appellants respectfully request that the Examiner set forth a clear explanation as to why Levy is somehow combinable with Jaeger.

Even assuming, *arguendo*, that Jaeger in view of Levy is properly combinable, any such combination would completely teach away from the present invention. As noted by the Federal Circuit:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. (emphasis added).

*Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d 1085 (Fed. Cir. 1995).

Appellants respectfully submit that it is clear that Jaeger does not teach, disclose, or suggest using its invention for anesthetic purposes and further more its system, unlike the present invention, does not account for the required modifications necessary for use in animals that require a volatile liquid anaesthetic to be vaporized. Furthermore, unlike the present invention, Levy does not teach, suggest, or disclose using breathing station compartments that would fill a chamber compartment with anesthetic without the use of masks to deliver anesthetic gases to laboratory animals. Therefore, unlike the present invention, Levy is unable to administer liquid anaesthetic to the laboratory animals. Nor is Levy able to deliver precise amounts of gas

anesthetics like the present invention.

It is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). (emphasis added).

In view of the foregoing, it is therefore respectfully submitted that 35 U.S.C. 103(a) rejections of claims 9-11 be withdrawn and that claims 9-11 be allowed.

## CONCLUSION

In view of the foregoing, Appellants respectfully request that the Board reverse the rejections of Claims 9-11 as set forth in the Office Action mailed March 16, 2009, that the Board allow the pending claims since they are in condition for allowance, and that the Board grant any other relief as it deems proper.

Dated: August 123, 2009

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

1-8. (Canceled)

9. A ventilation system comprising an induction chamber consisting of a plurality of compartments, including a first compartment where animals are initially anaesthetized having means for the supply and removal of anaesthetic, and a second compartment connected to an-inlet, the compartments being arranged such that anaesthetic escaping from the first compartment passes into the second compartment and thence to the inlet.

10. The ventilation system of claim 9, wherein said first and second compartments are joined by a selectively closeable passage.

11. The ventilation system of claim 9, wherein said inlet is at the top of the second compartment, and a lower region of said second compartment is provided with at least one ventilation hole for the intake of air.

12-19. (Canceled)

## **IX. EVIDENCE APPENDIX**

Appellants hereby present the following patents relied on by the Examiner:

Jaeger - U.S. Patent No. 5, 297,502; and

Levy - U.S. Patent No.: 4,332,244.

This is the evidence relied upon by the Examiner for rejection of appealed Claims 9-11 in the final Office Action dated March 16, 2009.

**X. RELATED PROCEEDINGS APPENDIX**

There are no other appeals or interferences related to the instant appeal